

DETAILED ACTION

The reply filed on 01/09/08 is not fully responsive to the prior Office action because of the following omission(s) or matter(s):

The response is incomplete, not reciting the required election of **a single cancer**, as required in the previous of Office action (p. 2).

“In order to be entitled to reconsideration or further examination, the applicant or patent owner must reply to the Office action. The reply by the applicant or patent owner must be reduced to a writing which distinctly and specifically points out the supposed errors in the examiner’s action and must reply to every ground of objection and rejection in the prior Office action. The reply must present arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over any applied references”. See 37 CFR 1.111.

In a telephonic conversation with the Attorney Siegfried J. Rupport on 01/08/08, Applicant asserts that the different groups of detecting of different cancers (groups 1-5) should be considered for rejoining together, because the claimed lung, breast, mesothelioma, colon cancer and sarcoma are all methylated at the promoter region of SEQ ID NO:3, and that methylation of SEQ ID NO:3 has been shown by Applicant to be correlated with a decrease in the transcript encoding SEQ ID NO:3.

After review and reconsideration, the different groups are **not rejoined** for the following reasons:

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The different methods are additional use of the transcript encoding SEQ ID NO:2 for detecting different cancers. Further, the different cancers as cited in claim 2 have different etiology, properties and characteristics. Except for lung cancer tissue (Example 2, on pages 52-53), the specification has not shown methylation in cancer tissues of breast, mesothelioma, colon cancer and sarcoma of CpG islands within the region from -1005 to -983 or from -754 to -737 of the promoter of SEQ ID NO:1. In addition the specification has not shown said methylation is responsible for reduction in the level of the nucleic acid SEQ ID NO:1 encoding SEQ ID NO:2, because the specification does not have any data or objective evidence that reduction of methylation found in lung cancer tissue, using methylation reducing compounds known in the art (p.42), results in an increase in the level of SEQ ID NO:1 in lung cancer cells. Further, the claims encompass cancers having methylation at any nucleotides, in any promoter region of any SOCS-3 variants (the instant specification, p.7), the structure of which is not disclosed. The claimed different cancers clearly do not have a common property of having methylation at any nucleotides, in any promoter region of any SOCS-3 variants, as encompassed in claim 1.

The requirement is still deemed to be proper and therefore made FINAL.

Since the above-mentioned reply appears to be bona fide, applicant is given a TIME PERIOD of ONE (1) MONTH or THIRTY (30) DAYS from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MINH-TAM DAVIS whose telephone number is 571-272-0830. The examiner can normally be reached on 9:00 AM-5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, LARRY HELMS can be reached on 571-272-0832. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MINH TAM DAVIS
December 15, 2008

/Larry R. Helms/

Supervisory Patent Examiner, Art Unit 1643